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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHIN, HUI H

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,788	Applicant(s) NAKASHIMA ET AL.	
	Examiner HUI CHIN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/25/2006, 12/18/2006, 1/16/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The office action is in reference to the Preliminary Amendment, filed on 9/25/2006.

Claims 21-22 were cancelled. Claims 1-20 are now pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 4-5, 7-8, 10-16, and 20 are rejected under 35 U.S.C. 102 (b) as being anticipated by Aoyama ET al. (JP 2003055528).

Aoyama et al. disclose a sealing material composition comprising (A) an alkenyl group-terminated isobutylene-based polymer, (B) a thermoplastic resin, and (C) a compound containing at least two hydrosilyl groups (claims 1, 8, and [0023]).

The limitations of claim 4 can be found in Aoyama et al. at claim 8 and [0023], where it discloses the crosslinking agent.

The limitations of claim 5 can be found in Aoyama et al. at [0024], where it discloses the process.

The limitations of claim 7 can be found in Aoyama et al. at [0036], where it discloses the inorganic filler.

The limitations of claim 8 can be found in Aoyama et al. at [0037], where it discloses the plasticizer.

The limitations of claim 10 can be found in Aoyama et al. at claim 5, where it discloses the isobutylene.

The limitations of claim 11 can be found in Aoyama et al. at [0013], where it discloses the styrene.

The limitations of claim 12 can be found in Aoyama et al. at Example 1, where it discloses the SIBS.

The limitations of claims 13 and 14 can be found in Aoyama et al. at [0015], where it discloses the diblock and triblock.

The limitations of claims 15 and 16 can be found in Aoyama et al. at [0024] and [0026], where it discloses the polyorganohydrogensiloxane.

The limitations of claim 20 can be found in Aoyama et al. at [0046], where it discloses the sealing material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, and 17-18 are rejected under 35 U.S.C. 103(a) as obvious over Aoyama et al. (JP 2003055528) in view of Kohno et al. (US 20060111536).

The disclosure of the sealing material by Aoyama et al. is adequately set forth in paragraph 2 and is incorporated herein by reference.

However, Aoyama et al. are silent on the specific carbon-carbon unsaturated bond-containing functional group-containing compound.

Kohno et al. disclose an organic polymer having epoxy-containing compound which has an unsaturated group at an end such as ally glycidyl ether (abstract, [0068]) to provide excellent weather resistance, flexibility, compatibility with other components for sealing applications ([0004], [0125]). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use this specific carbon-carbon unsaturated bond-containing functional group-containing compound to make the sealing material with the expected success.

5. Claims 3 and 19 are rejected under 35 U.S.C. 103(a) as obvious over Aoyama et al. (JP 2003055528) in view of Onizawa (US Patent 6,255,394).

The disclosure of the sealing material by Aoyama et al. is adequately set forth in paragraph 2 and is incorporated herein by reference.

However, Aoyama et al. are silent on the specific nitrogen atom-containing compound.

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Onizawa discloses a sealing composition comprising using a specific nitrogen atom-containing compound such as isophthalic acid hydrazide with isobutylene block copolymers and an olefin resin (claims 1 and 4) which provides crosslinked rubber with a high hardness for applications such as in sealing (col. 1, lines 60-62). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use this specific nitrogen atom-containing compound to make the sealing material with the expected success.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as obvious over Aoyama et al. (JP 2003055528) in view of Fukui et al. (JP 2003026896).

The disclosure of the sealing material by Aoyama et al. is adequately set forth in paragraph 2 and is incorporated herein by reference.

However, Aoyama et al. are silent on the use of a tackifier.

Fukui et al. disclose a sealing composition comprising using a tackifier with isobutylene block copolymers and an olefin resin (claim 1, [0034], [0062]) to obtain a better plasticity, molding workability, and mechanical strength ([0001]). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the tackifier to make the sealing material with the expected success.

The limitations of claim 9 can be found in Fukui et al. at [0030], where it discloses the alkoxysilane compound.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUI CHIN whose telephone number is (571)270-7350. The examiner can normally be reached on Monday to Friday; 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/
Primary Examiner, Art Unit 1796

/HC/